Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM Y. CONWELL and KENNETH L. LEVY

Appeal No. 2004-2215
Application No. 09/578,551

ON BRIEF

Before THOMAS, DIXON, and GROSS, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1 through 27.

Representative claim 14 is reproduced below:

> 14. A method of managing a universe of identifiers, some of said identifiers being active and having internet resources associated therewith, and others of said identifiers being inactive, the method including receiving a query corresponding to an inactive identifier and, in response, initiating a time-limited auction, a winner of said auction being granted the privilege of associating an internet resource with said identifier for at least a predetermined time period.

The following references are relied on by the examiner:

Davis et al. (Davis)	6,269,361	Jul. 31, 2001 (filed May 28, 1999)
Eyal	6,389,467	May 14, 2002 (filed May 2, 2000)
Thomas	6,401,118	Jun. 4, 2002 (filed Aug. 13, 1998)

Claims 14, 16, 17 and 25 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Davis. The remaining claims on appeal stand rejected under 35 U.S.C. § 103. Thus, the examiner considers that 1-5, 7 through 12, 15, 18 through 24, 26 and 27 would have been obvious in light of Davis in view of Eyal, with the addition of Thomas as to claims 6 and 13.

Rather than repeat the positions of the appellants and the examiner, reference is made to the brief and reply brief for the appellants' positions, and to the answer for the examiner's positions.

OPINION

We reverse. Since we find ourselves in substantial agreement with what appellants have argued in the brief and repeated in the reply brief, we reverse the rejection of certain rejections under 35 U.S.C. § 102 and the rejection of the remaining claims under 35 U.S.C. § 103 for the reasons set forth by the appellants.

The examiner's statement of the rejection and reliance upon certain portions of the respective references relied upon in various rejections before us is essentially repeated in the responsive arguments portion of the answer. As the reader will clearly conclude, the positions set forth by the examiner in the answer are not supported by the corresponding noted portions in the respective references to support the positions asserted.

Turning first to the rejection of independent claims 14 and 16 under 35 U.S.C. § 102, as to claim 14, we agree with appellants' views expressed at page 9 of the brief which have been essentially repeated in the reply brief at page 5:

> The Office cites Davis, at Col. 21, lines 7-13 (see February 10, 2003 Final Office Action, page 4, lines 6-11), as showing the feature of, in response to receiving a query corresponding to an inactive identifier, initiating a time-limited auction, a winner of said auction being granted the privilege of associating an internet resource with said identifier for at least a predetermined time period. Applicants respectfully disagree.
>
> The cited Davis passage suggests generating a cost prediction for a search listing at a given price bid. While the cost estimate at a given bid is calculated with respect to a fixed time period, the auction itself is not so limited. A Davis-like advertiser could enter a higher bid at anytime, where a higher bid can always supplant others. Thus, the cited passage is deficient in teaching the initiation of a time-limited auction, where a winner of the auction is granted the privilege of associating an internet resource with the identifier for at least a predetermined time period, in combination with the other features of claim 14.

Next, in considering the limitations of independent claim 16, again, we agree with the positions set forth by appellants at page 10 of the principal brief which have been essentially repeated at page 6 of the reply brief:

> The Office cites Davis, at Col. 21, lines 23-25 (see the Final Office Action, page 4), as showing the features of auctioning to the highest bidder the privilege of defining a link that is to be associated, for a predetermined time period, with an identifier through a database; and at the expiry of said predetermined time period, re-auctioning said privilege. Applicants respectfully disagree.
>
> The cited passage of Davis deals with generating a cost prediction for a search listing at a given bid, not auctioning a privilege for a predetermined time period and at the expiry of the predetermined time period, re-auctioning the privilege.
>
> The Davis cost projections are estimations for daily run rates and the like, not re-auctions of a privilege of defining a link that is to be associated for a predetermined time period with an identifier through a database.

The claimed time limited auction and predetermined time periods of claims 14 and 16 are in essence the opposite of the open auction environment, open market, real time continual bidding process discussed generally at columns 3-6 of Davis.

Lastly, we look at the separate rejection of independent claims 1 and 4 under 35 U.S.C. § 103 in light of the collective teachings and showings of Davis in view of Eyal. For purposes of our consideration here and to simplify our consideration of the

issues, we assume for the sake of argument that Davis and Eyal are properly combined within 35 U.S.C. § 103. As relied upon by the examiner, the latter lines of the abstract of Davis generally teach the generation of a rank value among all search listings having a given search term, such that the rank value is generated by the bidding process to determine where the listing will appear on the search results list page generated in response to a search query term. Generally, the higher the bid by a network information provider will result in a higher rank value and a more advantageous placement in the presentation to the query user.

It is against this background that we reproduce the portions of pages 13 and 14 of the brief on appeal relative to the rejection of claim 1:

> Again Davis is deficient in supporting an identifier being derived from an existing media content object in combination with the features of claim 1. A search term - and not a generated "rank value" - is used to identify content in the Davis Scheme. The rank value merely determines a listing order once content is identified.
>
> Applicants also note that Office's comments on page 2, lines 6-11 of paragraph 3, of the Final Office Action. Applicants disagree that the cited Eyal reference discusses "deriving an identifier from an existing media content object." While the cited Eyal passage (Col. 12, lines 13-17) may discuss providing access to media via links found at a media site, it does not support an identifier being derived from an existing media content object.

In a corresponding manner, we reproduce here the corresponding arguments as to independent claim 4 as set forth at pages 15 and 16 of the brief:

> Applicants remain puzzled by the Office's rejection of claim 4 over Davis and Eyal. For example, the Office cites Davis at the Abstract, lines 22-34, as teaching "deriving an identifier corresponding to an existing media content object". As best as can be understood by applicants, the Office intended the "rank value" associated with a searching listing to support applicants' deriving step. This conclusion is reached since the "rank value" is the only value derived or generated in the Davis passage cited by the Office. But Davis' rank value is not used to query a database (*cf.* claim 4: "*querying a database with the derived identifier*"). Instead, a search term is used to query the search engine (see Davis at its Abstract, lines 27-31).
>
> Moreover, the proposed Davis-Eyal combination is not understood to teach or suggest "*if the database has no active record corresponding to said derived identifier, permitting a party who first queried the database with said identifier to define such a record.*" The cited Davis passage (Col. 5, lines 34-48) contemplates a bidding process, including multiple bids. In contrast, claim 4 would permit a party who <u>first</u> queried the database with the identifier to define a record.
>
> Eyal is not relied upon by the Office to remedy these deficiencies. Nor is it understood to do so.

As to the rejection of independent claims 1 and 4 under 35 U.S.C. § 103, the examiner's rationale does not refer to the prior art assessment at specification pages 1 and 2 that it was known in the art to derive identifiers from the content of the query. Even if this were the case, it is not apparent to us that

the subject matter of independent claims 1 and 4 would have been obvious to the artisan in light of the additional teachings provided by Davis and Eyal combined.

Essentially, the portions of the respective references relied upon by the examiner do not support the examiner's view as to the argued features also questioned by appellants in the brief and reply brief. Since we do not sustain the rejection of independent claim 4 rejected under 35 U.S.C. § 103, we do not sustain the additional rejection of respective dependent claims 6 and 13 in light of the further teachings of Thomas which do not appear to us to make up for the deficiencies noted with respect to the combination of Davis and Eyal, and the examiner's positions with respect to Thomas do not assert this either.

Since we do not sustain the rejections of various claims under 35 U.S.C. § 102 and 35 U.S.C. § 103, the decision of the examiner rejecting all claims on appeal, claims 1 through 27, is reversed.

REVERSED

JAMES D. THOMAS
Administrative Patent Judge)

JOSEPH L. DIXON
Administrative Patent Judge)

ANITA PELLMAN GROSS
Administrative Patent Judge)

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JDT/hh

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